

## REMARKS

### Rejections under 35 U.S.C. §112, 2<sup>nd</sup> paragraph

The Examiner rejected claims 25 and 27 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite in the recitation of “having a nucleotide sequence consisting of”. The Examiner also rejected claims 29 and 36 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as ambiguous in the recitation of “a polypeptide comprising SEQ ID NO:2 *may be expressed* by a cell...”.

In response, Applicants have amended claims 25, 27, 29, and 36, as indicated above, to clarify the claims.

### Provisional Rejection under 35 U.S.C. §102(e)

The Examiner provisionally rejected claims 4, 8-9, and 24-37 under 35 U.S.C. §102(e) as being anticipated by copending Application No. 10/170,235, which has a common Assignee with the instant application, if copending Application No. 10/170,235 were to be published or patented.

In response, Applicants hereby submit a declaration under 37 CFR §1.131, which accompanies this Response to Office Action, to show that the invention claimed in claims 4, 8-9, and 24-37 of the present application was invented prior to the disclosure of the relevant sequence (the transcript sequence having Celera hCT identification number hCT1957421, which is identified as SEQ ID NO:1 in the present application) in copending Application No. 10/170,235, or in any provisional applications for which Application No. 10/170,235 claims benefit of. Specifically, the attached declaration under 37 CFR §1.131 demonstrates that the transcript sequence of SEQ ID NO:1 (as well as the encoded protein sequence of SEQ ID NO:2) was invented on September 7, 2001.

[hCT1957421 corresponds to the following SEQ ID NOS (these SEQ ID NOS can be readily obtained by searching Table 1 in each application for “hCT1957421”): SEQ ID NO:5362 in regular application 10/170,235, filed 6/13/02, and in provisional application 60/372,442, filed 4/16/02; SEQ ID NO:1742 in provisional application 60/363,301, filed 3/11/02; SEQ ID NO:744 in provisional application 60/352,258, filed 1/30/02; SEQ ID

NO:3429 in provisional application 60/346,393, filed 1/9/02; SEQ ID NO:370 in provisional application 60/339,128, filed 12/13/01; and SEQ ID NO:3118 in provisional application 60/332,511, filed 11/26/01.]

Provisional Rejection under 35 U.S.C. §101 (Double Patenting)

The Examiner provisionally rejected claims 4, 25-27, and 31 under 35 U.S.C. §101 as claiming the same invention as that of claims 4, 8, 12, and 16 of copending Application No. 10/170,235. Thus, the Examiner has based this rejection on double patenting of the “same invention” type, which means an invention drawn to identical subject matter.

In response, Applicants respectfully assert that a double patenting rejection of the “same invention” type is clearly not proper since claims 4, 25-27, and 31 in the present application are directed to isolated nucleic acid molecules, whereas claims 4, 8, 12, and 16 of copending application No. 10/170,235 are directed to nucleic acid arrays, and therefore are not drawn to identical subject matter. Moreover, claims 4, 8, 12, and 16 of copending application No. 10/170,235 are directed to nucleic acid arrays for detecting 100,000 or more, 1000 or more, 5000 or more, and 10,000 or more, respectively, human exons. Clearly, these are not the same invention as claimed in claims 4, 25-27, and 31 in the present application. Therefore, Applicants respectfully request that the Examiner withdraw the double patenting rejection under 35 U.S.C. §101 of claims 4, 25-27, and 31 in the present application.

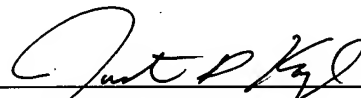
## Conclusions

By way of the above amendments, claims 25, 27, 29, and 36 have been amended. Claims 4, 8-9 and 24-37 remain pending. The amendments to the claims add no new subject matter and their entry is respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that the application and claims are in condition for allowance, and request that the Examiner reconsider and withdraw the rejections. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call the undersigned agent at (240) 453-3812 should the Examiner believe a telephone interview would advance prosecution of the application.

Respectfully submitted,

CELERA GENOMICS

By:   
Justin D. Karjala  
Reg. No. 43,704

Date: November 3, 2003

Celera Genomics Corporation  
45 West Gude Drive, C2-4#20  
Rockville, MD 20850  
Tel: 240-453-3812  
Fax: 240-453-3084

Attachment:

-Declaration under 37 CFR §1.131 (with "Exhibit A")